



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/625,089

07/22/2003

Jay S. Walker

97-054-C2

8766

22927 7590 09/10/2007
WALKER DIGITAL MANAGEMENT, LLC
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,089	Applicant(s) WALKER ET AL.	
	Examiner Charlie C. Agwumezie	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 185-189 and 192-201 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 185-189 and 192-201 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/22/03; 3/22/04; 3/25/04, 11/2/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of claims

1. Claims 1-184 and 190-191 is cancelled. Claim 192, and 194 are amended. Claims 195-201 are newly added. Claims 185-201 are pending in this application per the response to office action filed on June 25, 2007.

Terminal Disclaimer

2. The terminal disclaimer filed on October 5, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of **U.S. Patent No. 6,598,024** has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

2. The claim objection to **Claims 192 and 194**, under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim is hereby withdrawn subject to the amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 188 and 189, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically it is not clear whether the multiple of five (claim 188) and multiple of one (claim 189) includes negative numbers. Furthermore, it is unclear how this claim limitation related to the method steps of generating, generating, calculating and printing as recited in the independent claim 185

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 185-201, are rejected under 35 U.S.C. 103(a) as being unpatentable over Heads I win, tails you lose: Business, finance and science; Business Pg. 74 (herein after "The Economist") in view of Examiner's Official Notice.

As per **claims 185, and 193**, The Economist discloses a method implemented by a device, comprising:
generating a purchase price of a purchase (shopper goes to pay for goods
...suppose the purchase is for \$1.46);
generating a rounded price (total price rounded up or rounded down);

calculating a round-up amount (the price is rounded up for example to \$1 or \$2 depending on the value of the third number); the round-up amount being a difference between the purchase price and the rounded price (if the number is less than or equal to the amount of change in the price, the price is rounded up. If it is more the price is rounded down for example the difference between \$1.46 and \$2.00). The Economist does not explicitly disclose printing an entry in a lottery in which a prize for winning the lottery is proportional to the round-up amount. The Economist discloses that the idea is a benign form of gambling (lottery). The Examiner however takes official notice that this limitation is a non-functional descriptive material or in the alternative well known in the art. For example when 3 people purchase a lottery ticket for one dollar each. And let say the third person purchased an extra ticket such that the third person has two winning numbers and the other two persons have one winning number each. It then follows that each will be paid proportional to their winning such that the third person will receive two-thirds and the others one-third each. Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the printing of an entry in a lottery in which a prize for winning the lottery is proportional to the round-up amount so that the shopper and the cashier would be reasonably informed of the transaction.

186. As per claims 186, The Economist further discloses the method in which generating the rounded price comprises: rounding up the purchase price to a whole

Art Unit: 3621

number (suppose the purchase price is 1.46, if the...combined random number is less than or equal to 46, the price is rounded up to \$2.).

187. As per claim 187, The Economist further discloses the method, in which generating the rounded price comprises: calculating a lowest whole number that is greater than the purchase price (suppose the purchase price is 1.46, if the...combined random number is less than or equal to 46, the price is rounded up to \$2).

As per claims 192, and 194, The Economist discloses an apparatus, comprising:
a processor (cash register) and
a memory storage device in communication with the processor, the memory storage device storing a program which controls the processor to (shopper's cash register is programmed to do so)
generating a purchase price of a purchase (shopper goes to pay for goods
...suppose the purchase is for \$1.46);
generating a rounded price (total price rounded up or rounded down);
calculating a round-up amount (the price is rounded up for example to \$1 or \$2 depending on the value of the third number); the round-up amount being a difference between the purchase price and the rounded price (if the number is less than or equal to the amount of change in the price, the price is rounded up. If it is more the price is rounded down for example the difference between \$1.46 and \$2.00). The Economist does not explicitly disclose. printing an entry in a lottery in which a prize for winning the

Art Unit: 3621

lottery is proportional to the round-up amount. The Economist discloses that the idea is a benign form of gambling (lottery). The Examiner however takes official notice that this limitation is a non-functional descriptive material or in the alternative well known in the art. For example when 3 people purchases a lottery ticket for one dollar each. And let say the third person purchased an extra ticket such that the third person has two winning number and the other two persons has one winning number each. It then follows that the each will be paid proportional to their winning such that third person will receive two-third and the others one third each. Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the printing of an entry in a lottery in which a prize for winning the lottery is proportional to the round-up amount so that the shopper and the cashier would be reasonably informed of the transaction.

195. As per **claim 195**, The Economist does not expressly show the method, in which displaying the offer comprises: displaying text explaining that the entry in the lottery may be purchased for the round-up amount.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The purchase and/or round up transaction would be performed the same regardless of displaying text explaining that the entry in the lottery may be purchased for the round-up amount. Thus,

this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to displaying text explaining that the entry in the lottery may be purchased for the round-up amount because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

196. As per claim 196, The Economist does not expressly show the method, in which displaying the offer comprises: displaying text that identifies at least one of the round-up amount and the rounded price.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The purchase and/or round up transaction would be performed the same regardless of displaying text that identifies at least one of the round-up amount and the rounded price. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to displaying text that identifies at least one of the round-up amount and the rounded price because such data does not functionally relate to the

steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per **claim 197**, The Economist does not expressly show the method, further comprising: printing the entry. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to printing an entry so that both the shopper and Cashier would be reasonably informed about the transaction.

198. As per **claim 198**, The Economist further discloses the method, further comprising: receiving an input indicating acceptance of the offer (shopper picks a number and the cash register is programmed to do so).

199. As per **claim 199**, The Economist does not explicitly disclose the method, further comprising: determining a unique identifier that identifies the entry. However it would have been obvious to one of ordinary skill in the art to identify the transaction so that both the shopper and the cashier would be reasonably informed as to the transaction especially in case of winning the lottery.

200. As per **claim 200**, The Economist further discloses the method, further comprising: storing the unique identifier and the round-up amount in a database (the shopper electronic register should store the transaction for example for record purposes).

201. As per **claim 201**, The Economist further discloses the method, further comprising: determines a value of the prize (suppose the purchase price is 1.46).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Charles C. Agwumezie** whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Andrew Fischer** can be reached on **(571) 272 – 6779**.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

Art Unit: 3621

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charlie Lion Agwumezie
Patent Examiner
Art Unit 3621

Acc
August 30, 2007

 9/4/07
ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600